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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/547,063 | 01/24/2006 | Gregor Dudziak | 104917-2-WCG | 6170 |
| 27386 7590 09/11/2008 NORRIS, MCLAUGHLIN & MARCUS, P.A. 875 THIRD AVE 18TH FLOOR NEW YORK, NY 10022 | | | | |
| EXAMINER MENON, KRISHNAN S | | | | |
| ART UNIT | | PAPER NUMBER | | |
| 1797 | | | | |
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| 09/11/2008 | | PAPER | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/547,063

Applicant(s)

DUDZIAK ET AL.

Examiner

Krishnan S. Menon

Art Unit

1797

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 July 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 8-11 and 20-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 12-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date 2/6/06, 8/25/05
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claims 1-22 are pending as preliminarily amended 8/25/05, of which claims 8-11 and 20-22 are withdrawn.

Election/Restrictions

Applicant's election with traverse of Group I, claims 1-7 and 12-19 in the reply filed on 7/22/08 is acknowledged. The traversal is on the ground(s) that there is no additional burden on searching. This is not found persuasive because the two groups are for different inventions, and the process claims would require separate and additional burden of search compared to the product claims, as shown in the restriction requirement.

Claims 8-11 and 20-22 are withdrawn from consideration.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 102/103

1. Claims 1-6 and 12-19 are rejected under 35 U.S.C. 102(b) as being anticipated by, or in the alternative, under 35 USC 103(a) as being obvious over, Van 'T Veen et al (US 5,089,299).

Van 'T Veen teaches a hydrophobic ultrafiltration and hyperfiltration membranes with ceramic support and hydrophobic coating as claimed – see abstract, column 3, lines 18-34, and column 6, lines 27-34. The reference does not use the terminology “nanofiltration” but hyperfiltration range encompasses nanofiltration, as is clear from the pore sizes described, as well as it being known

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in the art. The hydrophobic coating is silanes – see column 4, lines 18-36. The substrate is ceramic – column 3, lines 5-12. The various types of siloxanes recited are also taught by the reference.

2. Claims 1-7 and 12-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Van 'T Veen in combination with Hying et al (US 6,383,386).

Van 'T Veen teaches hydrophobic nanofiltration membranes as shown above in paragraph 1.

Hying teaches ceramic hydrophobic membranes (abstract) with pore size ranging from 1 nm to 500 nm, the hydrophobing being conducted by known hydrophobing methods and includes silanes containing fluorine – see column 4, line 51 – column 5, line 8.

It would be obvious to one of ordinary skill in the art to combine the teachings of these references to arrive at applicant's invention because the combination would have predictable results. See *KSR Int'l. v. Teleflex Inc.*, 127 S. Ct. 1727, 1732, 82 USPQ2d 1385, 1390 (2007). "it is commonsense that familiar items have obvious uses beyond their primary purposes, and a person of ordinary skill often will be able to fit the teachings of multiple patents together like pieces of a puzzle". "The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results."

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Krishnan S. Menon whose telephone number is 571-272-1143. The examiner can normally be reached on 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David R. Sample can be reached on 571-272-1376. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Krishnan S Menon/
Primary Examiner, Art Unit 1797